

1 THE HONORABLE JAMES L. ROBART
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10 UNITED STATES DISTRICT COURT
11 FOR THE WESTERN DISTRICT OF WASHINGTON
12 AT SEATTLE
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15 DEEP9 CORPORATION,

No. 11-cv-00035-JLR

16 Plaintiff,

17 v.
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AMENDED JOINT STATUS REPORT
AND DISCOVERY PLAN

BARNES & NOBLE, INC. and
BARNESANDNOBLE.COM, LLC,

Defendants.

The parties hereby submit this Joint Status Report and Discovery Plan (“Joint Report”) pursuant to Federal Rules of Civil Procedure 16 and 26; this Court’s February 3, 2011 Order Regarding Initial Disclosure, Joint Status Report, and Early Settlement; Local Patent Rule 110, and the Court’s comments at the April 13, 2011 Scheduling Conference. This Amended Joint Status Report supplants the Joint Status Report filed by the parties on April 4, 2011.

A. Nature and Complexity of the Case

This is a patent infringement action. Plaintiff claims to be the owner of two U.S. patents, U.S. Patent Nos. 5,937,405 and 6,377,951, each entitled “On-Line Database Updating Network System and Method.” Defendants market and sell e-reader devices and products, including NOOK and NOOK Color. Plaintiff contends defendants’ e-reader products infringe

1 its patents. Defendants deny infringement and have asserted a counterclaim seeking a
2 declaration of patent non-infringement and invalidity.

3 **B. ADR Method and Timing**

4 Consistent with Local Rule W.D. Wash. 39.1, the parties have agreed to mediate this
5 case. The parties also agree that mediation would best occur after the Claim Construction
6 hearing and ruling, and have proposed a mediation deadline after the expected date of a claim
7 construction ruling.

8 **C. Deadline for Joinder of Additional Parties and Amendment of Pleadings**

9 Neither plaintiff nor defendants anticipate joining additional parties. However, all
10 parties agree that any joinder will be made within 60 days from submission of this Joint
11 Report. The parties do not presently anticipate any further amendments of pleadings; if any
12 such amendments are required, the parties agree to comply with Fed. R. Civ. P. 15.

13 **D. Proposed Discovery Plan**

14 **1. Rule 26(f) Conference and Rule 26(a) Initial Disclosures**

15 A Fed. R. Civ. P. 26(f) conference was commenced in New York on March 11, 2011.
16 The parties and their counsel attended in person and via video conference. Participants
17 included Deep9's principal, David Campbell, Plaintiff's counsel Jonathan Selbin, Eric Fastiff,
18 Jennifer Gross, Kim Stephens, and Christian Mammen. In attendance for defendants were
19 Barnes & Noble's Director of Intellectual Property, Jeffrey Snow, and defense counsel A.
20 Antony Pfeffer. The Parties completed their Rule 26(f) conference via email correspondence.

21 The Parties exchanged initial disclosures simultaneously with the filing of the April 4,
22 2011 Joint Status Report. The parties do not propose any changes to the timing, form or
23 requirement of Rule 26(a)(1) disclosures.

24 **2. Subject Matter and Phases of Discovery**

25 Discovery will generally be needed on claim construction, infringement, validity and
26 damages issues, including, *inter alia*, the structure, function and operation of the Accused
27

1 Products, Defendants' sales, licenses associated with Defendants' products, and the marketing
 2 of Defendants' products. Discovery will not be bifurcated or conducted in phases, and will not
 3 be stayed pending the Claim Construction hearing. The parties will work to structure
 4 discovery in line with the Court's instructions regarding limiting the scope of discovery in the
 5 early phases of this litigation.

6 The parties will exchange two rounds of expert reports, with issues to be covered in the
 7 opening expert reports being allocated according to which party has the burden of proof. As
 8 Plaintiff bears the burden of proof with respect to secondary considerations of non-
 9 obviousness, any opinion concerning secondary considerations of non-obviousness will be
 10 included in Plaintiff's opening expert report.

11 **3. Limitations on Discovery**

12 The parties propose the following modifications to the discovery limitations set forth in
 13 the Federal Rules of Civil Procedure:

14 General: For the purpose of calculating discovery limits, defendants Barnes & Noble,
 15 Inc. and barnesandnoble.com, LLC shall be considered one party; thus, the discovery limits
 16 provided in this report and in the Federal Rules of Civil Procedure shall be deemed to be per
 17 *side*.

18 Depositions: Rule 30's limit of 10 depositions per side, each deposition to be no more
 19 than 7 hours, will apply; however, defendants are authorized to depose David Campbell, the
 20 named inventor, for a single 14-hour deposition, on two consecutive or non-consecutive days,
 21 counting as a single deposition. The Court may authorize additional depositions for good
 22 cause shown. Additionally, the following limitations and qualifications apply:

- 23 • Rule 30(b)(6) deposition notices shall be subject to the presumptive 7-hour
 24 limit on a per-deposition-notice basis (e.g., regardless of the number of topics in
 25 a single Rule 30(b)(6) notice, and regardless of the number of individuals
 26 designated by the responding party to testify on the specified topics); a long list

1 of topics expected to require more than 7 hours of testimony should be
2 distributed among multiple separate deposition notices.

- 3 • Deposition exhibits used by each side shall be sequentially numbered; each side
4 shall be allocated a numeric range of exhibit numbers (e.g., Plaintiff has
5 Exhibits 1000-1999 and Defendants have Exhibits 2000-2999); to the extent
6 possible, when the same document is used by a party as an exhibit at multiple
7 depositions, the same exhibit number should be used for that document at each
8 deposition.

9 **4. Discovery Management**

10 **a. Discovery of Electronically Stored Information (“ESI”)**

11 The parties are in general agreement that as a default, the production of documents
12 shall be in TIFF format with appropriate load files (either Summation or Concordance
13 compatible, based on the requirements of the receiving party). The parties are in the process of
14 finalizing an ESI protocol.

15 **b. Confidentiality**

16 Because some confidential information is likely to be requested and discoverable in
17 this action, the Parties are in the process of final negotiations of a Stipulated Protective Order.
18 Pending entry of the Protective Order, the parties have agreed that confidential information
19 produced in discovery prior to the entry of the Protective Order may be designated “Outside
20 Counsel’s Eyes Only,” and that any such discovery may not be disclosed by the receiving
21 party to anyone except outside counsel of record in this action, without a Court order. All such
22 materials would be reproduced or redesignated promptly by the appropriate party after entry of
23 the Protective Order.

24 **E. Discovery Completion Date**

25 The parties propose discovery completion dates as set forth in the proposed case
26 management schedule, below.

1 **F. Denial of Consent to Referral to Magistrate**

2 The parties do not consent to assignment of this case to a United States Magistrate
3 Judge.

4 **G. Bifurcation**

5 The case will not be bifurcated.

6 **H. Pretrial Statements and Pretrial Order**

7 The parties do not agree at this time to dispense with pretrial statements and a pretrial
order.

8 **I. Suggestions for Shortening or Simplifying the Case**

9 The parties understand the Court's practice is to usually limit each claim construction
10 hearing to approximately 10 terms. The parties will work to limit the disputed claims to
11 actually be construed by the Court to meet this limit.

12 **J. Trial**

13 Plaintiff requests a jury trial. The parties propose a trial commencing on the date
14 shown in the proposed case management schedule, below.

15 **K. Trial Counsel**

16 **1. For Plaintiff**

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35 **3. Service**

36 Service on defendants has been completed.

1 **4. Scheduling Conference**

2 The parties attended a Scheduling Conference with the Court on April 13, 2011, and do
3 not presently believe an additional Scheduling Conference is necessary.

4 **5. ADDITIONAL TOPICS UNDER LOCAL PATENT RULE 110**

5 The foregoing states the information required by Local Patent Rule 110(1)-(4) and
6 (13)-(14). This section contains the remaining information required by LPR 110.

7 **a. Proposed Modification of Patent Rule Deadlines.**

8 The parties propose deadlines for LPR disclosures as set forth in the proposed case
9 management schedule, below.

10 **b. Whether Confidentiality Concerns Affect LPR Disclosures**

11 The parties have addressed this above with respect to confidentiality pending entry of a
12 Stipulated Protective Order.

13 **c. Tutorial**

14 The parties believe a tutorial of the subject technology may be helpful for the Court
15 and propose to conduct it in advance of the Claim Construction Hearing. The parties propose
16 a date for the tutorial in the proposed case management schedule, below.

17 **d. Discovery Prior to LPR 120 Disclosure**

18 As noted above, discovery will not be stayed.

19 **e. Preliminary Injunction/Dispositive Motions**

20 Plaintiff does not presently anticipate moving for summary judgment or a preliminary
21 injunction before the Claim Construction hearing.

22 **f. Discovery Limitations Related to Claim Construction**

23 The extent to which expert discovery should occur prior to the Claim Construction
24 hearing will be determined by, and limited to, any experts who are expected to testify live at
25 the Claim Construction hearing or who submit a declaration in support of a parties Claim
26 Construction briefing.

1 g. Court-Appointed Expert for Claim Construction

2 The Parties do not believe the Court should appoint an expert to hear and make
 3 recommendations on claim construction issues.

4 h. Nature of Claim Construction Hearing

5 The Court has indicated that it will permit live testimony at the Claim Construction
 6 hearing, if desired by the parties, but has noted that live testimony is rarely helpful. Moreover,
 7 the Claim Construction hearing will be conducted on a term-by-term basis, so live testimony
 8 may be cumbersome or ungainly. The parties will work together to limit the amount of live
 9 testimony, if any, to be presented at the Claim Construction hearing.

10 L. Proposed Case Management Schedule

11 The parties propose a case management schedule as follows:

12 Event	13 Deadline	13 Day
14 Scheduling Conference	4/13/2011	Wed
15 Preliminary Infringement Contentions	4/29/2011	Fri
16 Preliminary Invalidity Contentions	6/10/2011	Fri
17 Preliminary Claim Chart	7/22/2011	Fri
18 Joint Claim Chart	8/19/2011	Fri
19 Opening Markman Briefs (both sides)	9/2/2011	Fri
20 Markman tutorial hearing	9/14/2011	Wed
21 Rebuttal Markman Briefs (both sides)	9/30/2011	Fri
22 Markman Hearing	10/26/2011	Wed
23 Markman Order Expected		Mid-Dec
24 ADR Deadline	2/24/2012	Fri
25 Fact Discovery Cutoff	3/16/2012	Fri
26 Opening Expert Reports	4/6/2012	Fri

	Event	Deadline	Day
2	Rebuttal Expert Reports	5/4/2012	Fri
3	Expert Discovery Cutoff	6/15/2012	Fri
4	Summary judgment motions --last day to file	6/28/2012	Thu
5	Summary judgment hearings [noticed date on Court calendar]	7/20/2012	Fri
7	Motions in Limine, Trial Evidence List, Contentions of Fact and Law	8/30/2012	Thu
9	Pretrial conference	10/12/2012	Fri
10	Trial starts	10/29/2012	Mon

Dated: April 25, 2011

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11 *Attorneys for Plaintiff*

1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on April 25, 2011, I electronically filed the foregoing with the
3 Clerk of the Court using the CM/ECF system which will send electronic notification of such
4 filing to all counsel of record.

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6 Dated this 25th day of April, 2011.

7

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